

Remarks

After amendment, claims 1 to 27 are pending. No claims have been canceled, and no claims have been withdrawn from consideration. With regard to pending claims, claims 1, 12 and 20 have been amended. Claims 21 to 27 have been added.

The Amendments

Support for the amendments to claims 1, 12 and 20 and new claims 21-27 may be found in the specification at page 8, lines 23-26; page 11, lines 15-18 and Figures 1-5.

§ 102 Rejections

Claims 1-7, 9, 10 and 12-20 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,853,846 to Clark et al. (hereinafter Clark). Claims 1-20 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent 4,123,140 to Ryan et al. (hereinafter Ryan).

As discussed below, the rejection of the claims under 35 USC § 102(b) is incorrect and should be withdrawn.

§ 103 Rejections

Claims 6, 7, and 17 stand rejected under 35 USC § 103(a) as being unpatentable over Clark in view of Ryan.

As discussed below, the rejection of these claims under 35 USC § 103(a) as being unpatentable over Clark in view of Ryan is incorrect and should be withdrawn.

Discussion

The Examiner has rejected claims 1-7, 9, 10, and 12-20 as being anticipated by Clark. It is the Examiner's position that Clark discloses forming an array of pavement elements interconnected by a carrier web and that the interconnection is frangible.

The Examiner has rejected claims 1-20 as being anticipated by Ryan. It is the Examiner's position that Ryan discloses forming an array of pavement elements (Fig. 5) interconnected by a carrier web and that the connection between the elements is frangible.

Applicants disagree with the Examiner's position and submit that the Examiner has read disclosures into Clark and Ryan that simply are not present.

Turning first to Clark, this reference discloses a conformable magnetic article for underlayment beneath a traffic-bearing surface. The article is to be covered with a layer of pavement material so as to provide a magnetic signal through the traffic-bearing surface. This article is not a pavement marker as described in this application. Applicants have searched the Clark reference for any disclosure that discusses frangibility. They have not located any such teaching.

The Examiner has specifically referred to Figure 5 of Clark in support of his assertion that Clark discloses frangibility. However, nothing in that Figure or written description shows or mentions frangibility. To the contrary, Figure 5 only shows a continuous magnetic layer having raised portions along it. This does not teach frangibility between the raised portions and the continuous magnetic layer between the raised portions. The Examiner's assertion that the connections between the raised portions are frangible is an unsupported assertion and cannot sustain the rejection of claims 1-7, 9, 10 and 12-19 under 35 USC 102(a).

Likewise Clark cannot sustain the rejection of claim 20 under 35 USC 102(a). Claim 20 requires the presence of discrete pavement elements and a carrier web bonded to an upper portion of the elements. Neither of these features is disclosed in Clark.

Turning now to Ryan, this reference discloses a reflective **sheet**. It does not disclose a pavement marking. The sheet contains a number of spaced apart cavities that are covered with a cover film. The sheet of Ryan is intended for use in vertical application. For this reason alone, Ryan cannot sustain a rejection of claims 1-19 under 35 USC 102(a). However there are other reasons why Ryan does not sustain the Examiner's rejection.

Like Clark, this reference is silent with respect to the concept of frangibility. It does not mention frangibility in the specification. It does not show a frangible article in any of the Figures. Consequently, Ryan does not support the Examiner's assertion that the "connection between the elements is frangible." Ryan does not support the rejection of claims 1-19 under 35 USC 102(a).

Ryan also cannot sustain the rejection of claim 20 under 35 USC 102(a). As noted above, claim 20 requires the presence of discrete pavement elements and a carrier web. Neither of these features is disclosed by Ryan.

The rejection of claims 6, 7, 11 and 17 under 35 USC 103(a) over Clark in view of Ryan is likewise unsustainable. As noted above, neither of the references teaches or shows the concept of frangibility. As a result, their combination cannot suggest forming a frangible connection between the pavement elements.

New claims 21 to 27 have been added. These claims describe alternative embodiments of the invention which specify the presence of:

- a) protrusions having retroreflective side surfaces (claims 21-27);
- b) reflective beads on the side surfaces (claims 22 and 25); and
- c) cube corner reflective lenses on the side surfaces (claims 23 and 26).

Neither of the references discloses a pavement marker, let alone one having these features.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims, as amended, at an early date is solicited.

Respectfully submitted,

Date August 6, 2003

By: James V. Lilly
James V. Lilly, Reg. No.: 27,817
Telephone No.: (651) 733-1543

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833